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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,160

08/31/2005

Bernard Buathier

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EXAMINER

CUTLIFF, YATE KAI RENE

ART UNIT

PAPER NUMBER

1621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,160	<b>Applicant(s)</b> BUATHIER ET AL.	
	<b>Examiner</b> YATE' K. CUTLIFF	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/12/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

1. Claims 1 - 12 are pending.

Claims 1 - 12 are rejected.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 - 12 are rejected under 35 U.S.C. 102(b) as being anticipated by *Kempf et al* (U.S. 6,747,175).

4. The rejected Claims cover, inter alia, a process for preparing a aniline derivative of formula (I) by the reaction of formula (11) with a dihalogen X<sub>2</sub>, and by introducing the two compounds simultaneously into a polar aprotic solvent in a dihalogen to compound of formula (11) ration ranging from 1.9 to 2.5 and at a temperature ranging from 100 to 300°C. Further, in claim 2 Applicant defines formula (I). as 2,6-dichloro-para-trifluoromethylaniline. In claims 3 and 4 the solvent used in claim 1 is a chlorinated aliphatic solvent subsequently defined as dichloroethane. In claims 5 and 6 the solvent as a chlorinated aromatic solvent subsequently defined as monochlorobenzene. Claims 7-10 further limits the temperature and molar ranges. Lastly, in claims 11 and 12 the solvent used in the process of claim 2 is either a chlorinated aliphatic solvent or chlorinated aromatic solvent.

Kempf et al. discloses a method of chlorinating aniline. Applicant is directed to the discussion of Kempf et al. in the Office Action of July 19, 2007. Further, Kempf et al. discloses a process of synthesis of aniline which is chlorinated on the ring which comprises at least one carbon atom of the  $sp^3$  hybridization which is both prehalogenated and the carrier of a fluorine atom. (see column 1, lines 61 - 66).

Basically, Kempf et al. discloses all of the process features of the claimed invention. In Kempf et al. the reactants include a para-trifluoromethylaniline, chlorine (012) and monochlorobenzene (polar aprotic solvent). (see Example 1 results table, Test No. 3). Also, in Kempf et al. the substrate and the chlorine are introduced gradually and simultaneously over a heel of solvent or of reaction mass. (see column 3, lines 6-9).

5. Applicant's claimed process is disclosed in Kempf, in that the claimed process does not exclude the use of a polar protic solvent, i.e. hydrofluoric acid. The language of the preamble which recites the purpose of the claimed invention does not result in a process difference between Applicant's claimed invention the process disclosed by Kempf et al. in Example 1 and as stated in column 2, lines 34-37; because it does not exclude any additional components from the claimed process. Further, when reading the claims in light of the Specification, the claimed process does not disclose that polar protic solvents are excluded from the claimed process. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are

able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The question whether a reference “teaches away” from the invention is inapplicable to an anticipation analysis. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed.Cir. 1983). “The law of anticipation does not require that the reference ‘teach’ what the subject matter of the patent teaches . . . . [I]t is only necessary that the claims under attack, as construed by the court, ‘read on’ something disclosed in the reference.”, *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125, 227 USPQ 577, 588 (Fed.Cir. 1985) (in banc).

### ***Response to Arguments***

6. Applicant's arguments filed April 15, 2008 have been fully considered but they are not persuasive. Applicant respectfully argues that the claimed process does not require a polar protic solvent and that Applicant's claimed process produce higher yield than produced by Kempf's Example 1.

7. However, as set out above in the 102(b) rejection, the process as claimed does not exclude the use of a polar protic solvent.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., higher yield) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is known in the art that para-trifluoromethylaniline can be dichlorinated.

One of ordinary skill in the art would have been motivated to use a polar aprotic solvent because, as suggested by the teaching of Kempf et al., it is known in the art that the mixture of polar protic solvents and polar aprotic solvents are useful in a dichlorination reaction to produce 2,6-dicholor-para-trifluoromethylaniline.

One skilled in the art would be motivated to choose art recognized alternative solvents as a matter of choice based on such factors as availability and cost.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempf et al. (US 6,747,175) for reasons given in the previous office actions mailed July 19, 2007 and January 15, 2008.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YATE' K. CUTLIFF whose telephone number is (571)272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on (571) 272 - 0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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